

USSN 10/047,950  
Attorney Docket No. 9D-EC-19976 (040)

### **REMARKS/ARGUMENTS**

Claims 1-27 are pending in the application with claims 14-27 withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b).

Claims 1-13 stand rejected on various grounds.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloom (U.S. Pat. No. 6,974,928).

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kantarjiev et al. (U.S. Pat. No. 6,975,937).

Initially, an anticipation rejection requires the disclosure in a single prior art reference of each element of the claim under consideration be present. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. M.P.E.P. §2131.

Furthermore, when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on by the Examiner must be designated as nearly as practicable. Also, the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 C.F.R. §1.104(c)(4).

With respect to Bloom, applicant respectfully points out that this patent contains 25 drawing sheets and 152 columns of disclosure including the 45 claims. Claims 1, 2 and 4 of the instant application have been rejected as being anticipated by Bloom without the Examiner identifying any column, page or drawing where each of the elements of the rejected claims 1, 2 and 4 are taught in support of this rejection. Thus, the Examiner has failed to meet his burden of proof that Bloom anticipates applicants' invention as defined in any of the claims 1-13. The applicants have not found teachings within Bloom that anticipate the invention as claimed in claims 1, 2 and 4 and submit that such teachings are absent from Bloom. Thus, the rejection of claims 1, 2 and 4 as being anticipated by Bloom should be reconsidered and withdrawn.

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Similarly, with respect to Kantarjiev et al., the Examiner has not identified any column, page or drawing where each of the elements of the rejected claims 1, 2 and 5 are taught in support of this rejection. Thus, the Examiner has failed to meet his burden of proof that Kantarjiev et al. anticipates applicants' invention as defined in any of the claims 1-13. The applicants have not found teachings within Kantarjiev et al. that anticipate the invention as claimed in claims 1, 2 and 5 and submit that such teachings are absent from Kantarjiev et al.. Thus, the rejection of claims 1, 2 and 5 as being anticipated by Kantarjiev et al. should be reconsidered and withdrawn.

Claims 1-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over the "admitted prior art, as described in the written description of the specification." (Office Action, page 8). The Examiner once again makes a personal conclusory assertion that applicant has merely automated a method for accomplishing the "same well known results as had heretofore been accomplished via manual means (such as those described, for example, in the Background of the Invention, on pages 1-3 of the written specification)." (Office Action, pages 8 and 9). A general reference is made to pages 1-3 of applicants' specification without identifying any specific disclosure supporting this rejection. The Examiner goes on to conclude that it would have been obvious to one skilled in the art at the time the invention was made "to have modified the conventional manual method" without clearly identifying what admission by applicants constitutes this so called conventional manual method.

The primary defects in these conclusions are that there is NO "well known results as had heretofore been accomplished via manual means" and there is NO "conventional manual method". These are the Examiner's personal conclusions not admissions of the applicants'. Applicants previously pointed out that the Background of the Invention section describes information setting the real-life problems encountered by the assignee of the present invention while purveying goods in the market place and the thought processes undertaken by the inventors for recognizing and solving those problems. Page 2, lines 20-32 describe steps involved in crediting a customer for a product that is returned but this in no way constitutes an admission on which the invention as defined in claims 1-13 can justifiably be rejected. Thus, applicant requests that the rejection of claims 1-13 as being unpatentable over the admitted prior art be withdrawn.

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Claims 3 and 6-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bloom and, independently, over Kantarjiev et al. In both instances, official notice has been taken that "inputting a description of the damage to a delivered item being returned because of the damage" is well known, hence obvious, to those of ordinary skill in the art (Office Action, pages 10 and 11). However, no further qualification is provided such as into what type of device or how the damage information is input. Applicants traverse the assertion of official notice with respect to this step because at the time the invention was made, the act of inputting into a portable computing device electronic data indicative of at least one of a code indicative of damage type, a code indicative of surface type and a code indicative of damage location type as delineated in claim 3, was not capable of instant and unquestionable recognition to justify official notice being taken of such a fact. Applicants respectfully request documentary support of this position be produced or withdrawal of the rejection.

Applicants traverse the rejection of claims 6-13 as being inherent in the method of Bloom or Kantarjiev et al. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. M.P.E.P. §2112 IV. No rationale in support of this inherency rejection has been provided and it should therefore be reconsidered and withdrawn.

Applicants also traverse the rejection of claims 6-13 as being self-evident, well known or merely matters of design choice in view of Bloom or Kantarjiev et al. Claims 6-13 clearly delineate steps of a method designed to achieve specific results that were not well known at the time the invention was made or merely design choices. For example, claims 9, 10 and 11 delineate a sequence of elements for determining when a product should be picked up from a destination location. Applicants submit that these are specific steps, executed in a specific sequence to determine whether a product should be picked up, which steps may be used to protect against stolen products or fraud. This example was clearly not well known at the time the invention was made nor merely a matter of design choice. Thus, applicant requests reconsideration and withdrawal of the rejection of claims 6-13 as being self-evident, well known or merely matters of design choice and withdrawal of this rejection is requested.

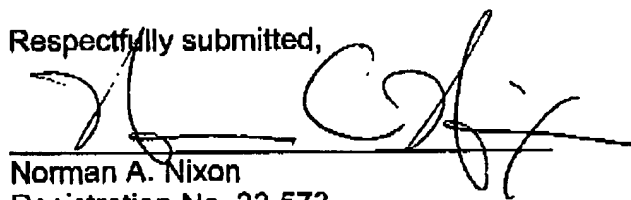
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Furthermore, applicant submits that no motivation is found in either Bloom or Kantarjiev et al., or in the knowledge available to one having ordinary skill in the art to modify their respective teachings either alone or in combination to arrive at the invention as claimed in claims 3 and 6-13.

In view of the above, applicant respectfully requests reconsideration of the merits of this invention and asserts that, based on the art of record to date, pending claims 1-13 are in condition for allowance. Notice to that effect is respectfully requested.

The Examiner is invited to call the undersigned if clarification is needed on any aspects of this Reply/Amendment, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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